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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,152	09/24/2003	Federico J. Benetti	GUID-008CON2	2852

36154 7590 10/13/2005

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EXAMINER	
PHILOGENE, PEDRO	

ART UNIT	PAPER NUMBER
3733	

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/670,152	BENETTI ET AL.	
	Examiner	Art Unit	
	Pedro Philogene	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-18 of U.S. Patent No. 6,199,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claim 12 are to be found in claims 8-18. The difference between claim 12 and claim 8 of the patent lies in the fat that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 8 of the patent is in effect a “species” of the “generic” invention of claim 12. It has been held that the generic invention is “anticipated” by the “species”. See in re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993). Since claim 12 is anticipated by claim 8 of the patent, it is not patentably distinct from claim 8.

Claims 12-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No.

6,736,774. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claim 12 are to be found in claims 1-5. The difference between claim 12 and claims 1-5 of the patent lies in the fat that the patent claims include many more elements and are thus much more specific. Thus the invention of claim 8 of the patent is in effect a "species" of the "generic" invention of claims 1-5. It has been held that the generic invention is "anticipated" by the "species". See in re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993). Since claim 12 is anticipated by claims 1-8 8 of the patent, it is not patentably distinct from claims 1-5.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Nicholas et al. (5,967,974).

With respect to claims 12, 31, Nicholas et al disclose a surgical apparatus for accessing a beating heart, the apparatus comprising a main body (110) configured to rest against the frontal body of a patient; and a lifting arm (126) movably mounted to the main body and adapted to engage and lift at least a portion of the ribs of the patient,

relative to reminder of the patient's body below the rib cage, when the patient is positioned horizontally; as set forth in column 4, lines 58-67, column 5, lines 1-7.

With respect to claims 12-30,32-36, Nicholas et al disclose all the limitations, as set forth in column 3, lines 8-56, column 4, lines 15-67, column 5, lines 1-67, column 6, lines 1-24; and as best seen in FIGS.1-18. As to the fiber optic light mounted on the apparatus, the use of fiber optic light in the retractor field is old and well know in the art, as best seen in the pertinent cited art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

3,680,546	08-1972	Asrican
5,025,779	06-1991	Bugge
6,033,425	03-2000	Looney et al.
3,807,393	04-1974	McDonald

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
October 05, 2005

PEDRO PHILOGENE
PRIMARY EXAMINER